

REMARKS

Claims 1-20 are currently pending in the application. Claims 4, 5, 7, 8, 9, 10, and 11 are currently amended to correct an informality in Claim 4 concerning the sequential numbering of subparagraphs. Claim 4 as originally presented incorrectly made reference to a subparagraph “(j)” where reference should have been made to subparagraph “(k)” in order to preserve the sequential numbering system employed in presenting these claims. A change to claim 4 has been made to correct this informality, and claims 5, 7, 8, 9, 10, and 11 are likewise amended to reflect such change.

Claims 1-8, 11-17, and 20 were rejected pursuant to 35 U.S.C. § 103(a) as obvious in view of U.S. Patent No. 6,230,325, to Iinuma. In essence, the Examiner has asserted that the prior art, such as described in Figure 1 of the application, subsumes the claimed invention, even though the prior art does not address the fundamental characteristic of the claimed invention, which is to provide custom-selected advertising to television viewers through the interaction of multiple systems. The basis for such rejection is the Examiner’s overly broad taking of official notice that, in effect, any use of advertising is *per se* obvious. Applicant respectfully traverses the Examiner’s taking of official notice in this regard as impermissible hindsight and as an improper assertion of technical fact in an area of esoteric technology without support by citation of any reference work. *See* MPEP 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 422-21 (CCPA 1970)).

Claims 9-10 and 18-19 were rejected pursuant to 35 U.S.C. § 103(a) as obvious in view of Iinuma and in further view of U.S. Patent No. 6,078,891 to Riordan et al. In rejecting these claims, the Examiner has in essence taken the position that Riordan et al. should be read as broadly anticipating claims involving the collection and use of consumer or marketing data.

The rejection of claims 1-20 is respectfully traversed for the reason that the claimed subject matter is not obvious pursuant to 35 U.S.C. § 103(a). The Examiner has failed (a) to consider the claimed invention as a whole, (b) to consider the references a whole to determine whether such references suggest the desirability and

thus the obviousness of making the combination, (c) to view the references without the benefit of impermissible hindsight vision afforded by the claimed invention, and (d) to determine obviousness according to the standard of reasonable expectation of success. *See* MPEP 2141.

Claims 1-8, 11-17, and 20

Claims 1-8, 11-17, and 20 were rejected as obvious in view of Iinuma, which describes a method and a system for making purchases, through an information network (which can be the internet), of items promoted via television or radio broadcast. Iinuma enables guide information to be displayed on users' televisions in a manner that superficially resembles the manner in which custom-selected advertising is displayed on users' televisions in the claimed invention. Iinuma does not, however, concern the provision of custom-selected advertising. The claimed invention, by contrast, involves a method and a system for advertising, via a network with user ID, to viewers of broadcast programming. The claimed invention enables multiple systems, not discussed in Iinuma, to interact to select and display user-tailored advertising and to present such advertising to a television viewer.

One potential embodiment of the claimed invention would be for the internet to serve as the network with user ID for providing user-tailored advertising selection to viewers of broadcast programming. The user ID and other data would identify a particular user so that the broadcasting system, an advertising agent system, and an advertiser system could interact to select and deliver user-specific advertising for incorporation into the user's private page, which may be displayed on the user's television screen. *See* Figures 3-6. This is not anticipated by prior art. The claimed invention's use of the interaction of multiple systems to generate a custom-selected presentation of advertising to the user, *see* Figure 3, has no analog in Iinuma.

Iinuma does not provide for the selection or display of third-party advertising but instead provides for the display of guide information, which originates from the broadcaster's internal database rather than from advertising agents and advertisers as described in the claimed invention. Because Iinuma provides such guide information from a database, instead of providing advertising like the claimed invention, the

functionality of Iinuma is not analogous to that of the claimed invention which permits an advertising agent system, advertiser system, and service system to identify and deliver advertising deemed to be appropriate for a particular user. It is that functionality which distinguishes the claimed invention, as shown in Figure 2, from the prior art, as shown in Figure 1.

In rejecting claims 1-8, 11-17, and 20, the Examiner has asserted that the circumstances warrant taking official notice that

[I]t is old and well know[n] for an advertiser to request an advertising agency to advertise articles and for the advertising agency to produce an advertisement program, then transmit the produced advertisement program to the broadcasting station and finally, request the broadcasting or the advertisement program.

The “old and well know[n]” practice described by the Examiner, however, does not describe the claimed invention. The familiar practice described by the Examiner typically involves an advertising agency taking weeks or months to produce and schedule television commercials, which are subsequently shown during commercial breaks in the television programs. Such commercials are not tailored to particular viewers but are instead shown to a program’s full viewing audience. Thus, the “old and well know[n]” process described by the Examiner does not anticipate the claimed invention. Furthermore, the Examiner’s taking of official notice in this regard is overly broad, asserts a technical fact in an area of esoteric technology without support by citation of any reference work, and is therefore traversed as discussed above. There is no basis for rejecting claims 1-8, 11-17, and 20 under 35 U.S.C. § 103(a).

Claims 9-10 and 18-19

With reference to claims 9-10 and 18-19, the claimed invention makes it possible to select advertising more effectively by drawing on databases of consumer and marketing data in determining which advertisements are to be presented to a particular user.

The Examiner, recognizing that claims 9-10 and 18-19 are not obvious in view of Iinuma, has asserted that the claims should be taken as obvious in view of Iinuma

in combination with Riordan et al. Applicant respectfully points out that Riordan et al. concerns a method and a system for collecting and processing marketing data and credit authorization data through retail point-of-sale terminals. One skilled in the art of broadcasting would not consult Riordan et al. in developing a bi-directional broadcasting and delivering system with characteristics similar to those of the claimed invention.

Riordan et al. does not disclose a method or a system for employing a network with user ID to provide custom-selected advertising to viewers of a broadcast program. Nor does Riordan et al. otherwise discuss the use of data to select or provide advertising tailored to specific users. In fact, such a use of data might not be possible in the art which is relevant to Riordan et al. since it is recognized that use of customer-specific data collected pursuant to the method and system of Riordan et al. may be restricted, in particular as a result of legal or contractual limits or prohibitions on accessing customer-specific purchasing information. *See* Riordan et al., col. 11, lines 14-22. Thus, Riordan et al. does not anticipate the invention claimed herein.

The Examiner asserts that Riordan et al. teaches “in the background” that businesses seek to collect market data because market research is a very important business tool. Such an expansive reading of Riordan et al. overreaches, however, since it appears ultimately to lead to the conclusion that Riordan et al. generally anticipates any claims involving collection or use of marketing data. There is no basis for rejecting claims 10-11 and 18-19 under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing, Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

01-USPF-641-MK

Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael E. Whitham', is written over the typed name.

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